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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,310	12/17/2004	Hidehito Kotani	262507US0PCT	6711
22850	7590	08/30/2007		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER SHAW, AMANDA MARIE	
			ART UNIT 1634	PAPER NUMBER
			NOTIFICATION DATE 08/30/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Advisory Action Before the Filing of an Appeal Brief	Application No. 10/517,310	Applicant(s) KOTANI ET AL.	
	Examiner Amanda M. Shaw	Art Unit 1634	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 August 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: none.
Claim(s) objected to: 24-27.
Claim(s) rejected: 24-35.
Claim(s) withdrawn from consideration: 36-43.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____

Continuation of 3. NOTE: The proposed amendment of claim 24 to recite "a genomic nucleotide polymorphism corresponding to C421A" raises new issues under 35 USC 112 2nd paragraph because the term "corresponding" has not been clearly defined in the specification and because there is no art recognized definition for this term. Additionally the proposed amendment to claim 24 to recite "said polynucleotide polymorphism" lacks antecedent basis because although the claim previously refers to a "genomic nucleotide polymorphism" it does not refer to a "polynucleotide polymorphism". Further as amended the goal of the method and the final step of the method still do not clearly agree. One way to overcome this issue would be by amending the claims to recite i.e., "a method for predicting if a cell has a decreased capacity to excrete compound B". Additionally the Applicants have presented five new claims (Claims 44-48) that would require further search and consideration. For example if entered the amendments would necessitate a new search aimed at identifying the prior art most relevant and consideration of the prior art with regard to whether it anticipates or renders obvious the new limitations. Additionally the claims would need to be reviewed for any issues under 35 USC 101 or 112. Thus further search and consideration would be required.

Continuation of 5. Applicant's reply has overcome the following rejection(s): The rejection made under 35 USC 102(b) over claims 25, 28-31 and 35 as being anticipated by Imai is withdrawn in view of the perfection of the priority claim. The rejection made under 35 USC 103(a) over claims 25-27 as being obvious over Imai in view of Komatani is withdrawn in view of the perfection of the priority claim. The rejection made under 35 USC 103(a) over claim 32 as being obvious over Imai in view of Kwok is withdrawn in view of the perfection of the priority claim. The rejection made under 35 USC 103(a) over claim 33 as being obvious over Imai in view of Brow is withdrawn in view of the perfection of the priority claim.

Continuation of 11. does NOT place the application in condition for allowance because: Regarding the enablement rejection over claims 24-35 the Applicants have amended the claims. If the proposed amendments had been entered the rejections over claims 25-28 and 35 would be moot since these claims would be cancelled and the rejections over claims 24, 29-34 would have been withdrawn based on the Applicants amendments to the claims.

Regarding the 112 2nd paragraph rejections, if the proposed amendments had been entered the rejections over claims 25-28 and 35 would be moot since these claims would be cancelled. The rejection of claims 24 and 29-34 over the phrase "at position 421 of the ABCG2 gene of SEQ ID NO: 1" would be withdrawn based on amendments made to the claims. Further the rejection of claims 24 and 29-34 over the goal of the method and final step would be maintained because the goal of the method and the final step still do not clearly agree. Also the rejections of claim 32 over the use of the trademark Taqman and claim 33 over the use of the trademark Invader method would be maintained because the scope of the claims is uncertain since trademarks cannot be used in a claim as a limitation to identify or describe a particular method.



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